

In re Patent Application of:
ROBERT M. HERRIN
Serial No. 10/721,962
Filing Date: 11/25/2003

Remarks

Applicant and the undersigned would like to thank the Examiner for his efforts in the examination of this application. Claims 1-19 remain in the case. New Claims 46-56 are added by this amendment. No new matter is added.

Claims 1-19 were rejected under 35 USC §103(a) as being unpatentable over the single reference US Patent No. 5,971,906 to Tharpe, Jr. et al. The Examiner has also taken a position that features called for in the claimed invention are a matter of engineering design choice. The rejection of Claim 1-19 is traversed.

Respectfully, there are issues of fact that focus on a prior art reference that will determine whether the reference is properly used to reject a claimed invention as being obvious to one of skill in the art. The focus is not on the claimed invention. Based on MPEP 2141, in order for the Examiner to establish a *prima facie* case of obviousness, a rejection must satisfy the following criteria:

1. There must be some suggestion, teaching, or motivation to modify the reference or combine the references on which the rejection is based;
2. There must have been a reasonable expectation of success by the hypothetical person of ordinary skill in the art, at the time the invention was made, that the modification or combination would work to produce beneficial results; and
3. The prior art reference must teach or suggest all of the elements and limitations recited in the claims.

As addressed in the Declarations of Robert M. Herrin and Johnny M. Tharpe, Jr., it would appear that the Examiner has erred in his opinion that the claimed invention would have been obvious to one of skill in the art based on the teachings of US Patent No. 5,971,906 to Johnny M. Tharpe, Jr. and Robert M. Herrin.

By way of example, and with regard to Claim 1, and as clearly stated in the

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Declaration of Johnny Marion Tharpe, Jr., Tharpe '906 teaches first folding means to fold the end panels up perpendicular to the bottom panel and folding the side panels up to an obtuse angle relative to the bottom panel. The structure disclosed for such forming would not work for the present invention. In addition, the guide plate (158) called for in the amended Claim 1 and as originally presented in dependent Claim 8, now made independent Claim 8, does not exist in the Tharpe '906 disclosure, nor would it be suggested because of the need at the time the Tharpe '906 teachings were developed. As further stated in the Tharpe declaration, it is not obvious to make the many modifications to the apparatus in the Tharpe '906 as suggested by the Examiner so as to achieve the apparatus that forms a tray as disclosed in the above referenced pending application. Contrary to the Examiner's comments in the 10/06/2005 Office Action, it would not be simply a matter of engineering design choice to create a desired fold by making the first arm (228) moveable if element (212) were not moveable. The Examiner states that Tharpe '906 does not disclose whether or not element 228 is movably positioned as claimed in the pending application. However, the Examiner interprets Tharpe '906 showing a second folding arm 412 as being moveable to create folds. It is only through the Herrin disclosure of the present application that one would be guided to make such an observation or conclusion, making modifications as suggested by the Examiner would be extensive, and were not a consideration in the Tharpe' 906 matter.

As further supported with reference to the Declaration of Robert M. Herrin, the Examiner is asked to consider some factual differences between the teachings in the Tharpe '906 reference and the teachings in the pending application to better understand why it would not be proper to rely on the teachings of Tharpe '906 for rejecting claims in the pending matter. For example, Tharpe '906 teaches first folding means to fold the end panels up perpendicular to the bottom panel and folding the side panels up to an obtuse angle relative to the bottom panel. The structure disclosed for such forming

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would not work for the present invention. As stated in the Tharpe declaration with regard to the guide plate, the Tharpe '906 disclosure does not suggest such a structure because of the need at the time the Tharpe '906 teachings were developed.

With reference to dependent Claim 4, and as supported in both the Tharpe and Herrin Declaration, Tharpe '906 discloses an adhesive as a shuttle conveys the partially formed blank past adhesive applicators, thereby applying adhesive only to the outer surface of the minor side panels of the blank. Herrin's pending application applies the adhesive to the blank upstream of the platen, and prior to any forming of the blank. There was no motivation or suggestion in Tharpe '906 for such an arrangement of elements.

Further, the Examiner takes "official notice" that a rejection in a previous office action was not traversed and as a beveled edges and surface with depressions called for in the claimed invention are now considered as admitted prior art in accordance with MPEP 2144.03(c). Respectfully, and based on a reading of MPEP 2144.03, it would appear that it is only appropriate in limited circumstances for an Examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection, and such rejections should be judiciously applied. It would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his conclusion of common knowledge. The Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made. If Applicant challenges a factual assertion as not properly

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officially noticed or not properly based upon common knowledge, the Examiner must support the finding with adequate evidence. If Applicant adequately traverses the examiner's assertion of official notice, the Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration including specific factual statements and explanation to support the finding. Any rejection based on assertions that a fact is well known or is common knowledge in the art without documentary evidence to support the Examiner's conclusion should be judiciously applied.

In this regard, Applicant traverses the Examiner's opinion regarding the "beveled edges" and the "depressions for reducing the frictional contacting surface." Applicant would like to specifically point out that the beveled edges identified in the specification with reference to FIG. 9, and as called for in dependent Claims 7 and 16, by way of example, are judicially positioned for the rectangular peripheral portion of the platen to include bevelled corners cooperating with the guide plate for folding an inside corner support member of the formed tray. Further, the guide plate carried by the platen defined a periphery for providing a compression surface, and it is this compression surface that comprises the depressions (see Claim 9 by way of example) for reducing friction when the blank is being removed from contact therewith. Both features would not be considered common knowledge or well known in the art unless taken with the teachings of the present invention. Therefore, and as guided by MPEP 2144.03, if this argument is not convincing and the traverse is felt to be inadequate, the Examiner should include an explanation as to why it is felt to be inadequate.

In a previous Office Action, the Examiner interpreted the forming rails (guide arm (218) of Tharpe '906) as teaching the first folding arm (120) of the claimed invention. As taught by Tharpe '906, Col 6, Lines 53-56 and Line 64 to Col 7, Line 4, and FIG. 11, the guide arms (218) are described as including the four minor side panel elements (226),

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the opposing front and rear guide elements (228), and the major side panel guide elements (230). Tharpe '906 discloses these guide arm elements as being fixed for cooperating with the platen (212). The first folding arm (120) of the claimed invention is movable. In addition, and supported by the specification as originally filed, the first folding arm is positioned proximate and downstream the distal portion of the forming rail (reference made to Paragraphs 29, 36, and FIGS. 3 and 4, by way of example). This feature clearly distinguishes the claimed invention from any modification proposed by the Examiner using Tharpe '906 for guidance. A careful reading of the specification and claims for the present invention could not be interpreted that the forming rails (218) of Tharpe '906 are simply the first folding arm (120) of the claimed invention, since one element cannot be downstream of itself.

In an interview with the Examiner (23 August 2005), Applicant agreed to amend the claims to more clearly distinguish over the cited reference to Tharpe '906, and file an RCE in an effort to more effectively bring this case to patent issue. In addition, the Examiner indicated that a further search would be performed and further consideration given to the claims in the case. The continued use of the single reference to Tharpe '906 being made in a 35 USC §103(a) rejection would appear to further support the Applicant's position that it is only through the teachings of the Applicant that the Examiner could modify the cited reference. Further, as supported by the named inventors of Tharpe '906, the modification of the reference suggested by the Examiner is contrary to accepted wisdom of the inventors. As above addressed, amended Claim 1 now includes a guide plate operable with a peripheral portion of the platen. As supported by the specification (see par 34 by way of example) and by the attached Declarations, there is neither a suggestion nor motivation for such a structure in the Tharpe '906 disclosure. Further, there is no suggestion to modify the Tharpe '906 disclosure as suggested by the Examiner to arrive at the claimed invention, even without the guide plate feature. New Claims 51-56 present the invention I with varying

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scope to further the distinguishing features.

Replacing elements from the claimed invention with modified elements of Tharpe '906 as suggested by the Examiner would not allow the invention to function as intended. When one considers that extensive experimentation and testing took place during the development of the claimed invention, as stated in the Herrin Declaration, the elements, their cooperation with each other, and their positioning as disclosed and claimed would not be obvious to one of skill in the art, knowing the teachings of the Tharpe '906 reference, as suggested by the Examiner. Modification of the claimed invention based on the Tharpe '906 disclosure, as appearing to be suggested by the Examiner, would change the structure and operation of the claimed invention. It would therefore appear that the Examiner has taken too much liberty in extending the teachings as presented in Tharpe '906 to a teaching of the claimed invention. This is further supported by customers purchasing the claimed apparatus of the pending invention when they could have chosen that of Tharpe '906, as stated in the Herrin Declaration.

From the above presentation and attached Declarations, the Examiner is asked to accept that there is no suggestion, no teaching, and no motivation to modify the reference on which the rejection is based. Further, there was no reasonable expectation of success by the hypothetical person of ordinary skill in the art, at the time the invention was made, that the modification would work to produce beneficial results. Yet further, the cited reference does not teach nor does it suggest all of the elements and limitations recited in independent Claims 1, 8, 46, 48, and 51. Further, dependent Claims 2-7 and 9-19 depending from Claim 1; Claim 9 depending from Claim 8; Claim 47 depending from Claims 46; Claims 49-50 depending from 48; and Claims 52-56 depending from Claim 51 provide additional features further limiting their respective independent claims and as such are also felt to clearly distinguish over known and cited prior art. It is to be noted that originally filed dependent Claim 8 depending from Claim 1

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has been amended to include all the limitations of Claim 1 as originally filed. Such a claim as originally filed was felt to clearly distinguish over the prior art and should now be allowed as supported by the arguments herein presented and the Tharpe and Herrin Declarations.

Applicant respectfully submits that the above amendments and remarks place this application in a condition for allowance, and passage to issue is respectfully solicited. The Applicant and the undersigned would like to again thank the Examiner for his efforts in the examination of this application and for consideration of the claims in light of the arguments presented. If the further prosecution of the application can be facilitated through telephone interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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